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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,617	05/14/2001	Yohnosuke Furui	JP9-2000-0025-JP1 (8728-5)	9199

7590 09/08/2004

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,617

Applicant(s)

FURUI ET AL.

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/28/04, 7/22/04 ✓

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION***Priority***

1. The foreign priority claim filed on 14 January 2003 was not entered because the foreign priority claim was not filed during the time period set forth in 37 CFR 1.55(a)(1). For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f) or 365(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim (37 CFR 1.55(c)). The petition must be accompanied by (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d) and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

5. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "web site" in claims 1-15 is used by the claim to mean "an HTTP server that provides web pages and other stored data", while the accepted meaning is "a group of related HTML documents and associated files, scripts, and databases served up by an HTTP server." The term is indefinite because the specification does not clearly redefine the term. The examiner suggests that the term "web site" be replaced by the term "web server" or "content server." If the data manager is remote from the transmission source determiner, the applicant may wish to use the term "access server" or "authentication server/device."

6. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on

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notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “subscription information” in claim 5 is used by the claim to mean “content accessible to and only to subscribers”, while the accepted meaning is “information describing subscribers, including identity information and access rights.” The term is indefinite because the specification does not clearly redefine the term. The examiner suggests replacing this term with “restricted material”, “purchasable content,” and the like.

Information Disclosure Statement

7. The information disclosure statement filed 7/22/04 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The examiner suggests a translation of the abstract for foreign patent JP 2002-514863A, and a brief description of both Japanese-language NPL documents. A full translation of all foreign documents would be appreciated.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Knauff et al. (6,654,754).

10. For claim 1, Knauff teaches (abstract; col. 1, line 40 – col. 3, line 15) a web site (Fig. 1, #108 and #110) provided in a communication network (Fig. 1, #116) comprising:

- a. A data manager (Fig. 2, #216), for storing information to be provided across said communication network (col. 5, lines 55-65);
- b. A transmission source determiner (Fig. 3, #218; col. 6, line 65 – col. 7, line 15), for ascertaining the type of a transmission source from which an access request is received (Fig. 6, #506); and
- c. A response unit (Fig. 3, #204), for acquiring, from said data manager, information that is correlated with said type of said transmission source (col. 6, lines 15-30) obtained in accordance with the determination made by said transmission source determiner (col. 6, line 65 – col. 7, line 15), and for generating and returning a response that is consonant with said type of said transmission source of said access request (Fig. 5, #514 vs. #544),
- d. Wherein said data manager stores main information (Fig. 2, #216), for which access is limited, and metadata (Fig. 2, #210), which is information describing said main information (col. 6, lines 35-45), and
- e. Wherein, as the result of the determination by said transmission source determiner (col. 12, lines 5-20), when said transmission source of said access request has no right of access for said main information (Fig. 6, #540), said response unit obtains metadata that is then used to generate a response (Fig. 7, #704).

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11. For claim 2, Knauft teaches that when said transmission source of said access request identified by said transmission source determiner is a robot (col. 5, line 65 – col. 6, line 17) in a robot search engine (Fig. 2, #208) that is launched across said communication network (Fig. 2, #116), said response unit generates a response, as metadata, that includes a keyword concerning said main information (col. 2, lines 43-53).

12. For claim 3, Knauft teaches that said transmission source determiner includes a user agent register (Fig. 4) in which said robot, of said robot search engine, which is launched across said communication network (col. 12, lines 5-10), and a user agent header that said robot adds to said access request (col. 7, lines 33-65) are registered as correlating with each other (), and when the contents of said user agent header added to said access request that is received are registered in said user agent register (Fig. 11), said transmission source determiner determines said transmission source of said access request to be said robot of said robot search engine (col. 20, lines 1-6).

13. For claim 4, Knauft teaches that said transmission source determiner includes a user register (Fig. 4) in which each access right of a user for said main information is registered (col. 10, lines 50-60). When a user ID (col. 12, lines 5-10), provided as cookie information, together with said access request that is received (col. 13, lines 65-col. 14, line 7; cookies are functionally equivalent to the identity information sent during a request), is registered in said user register, said transmission source determiner notifies said response unit of the range of said access rights of said user that is indicated in said user register (col. 14, lines 7-15). In accordance with said range of said access rights of said user, which is received from said transmission source determiner, said response unit generates a response, as metadata, that includes text data for

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describing the contents of said main information that is requested by said access request (col. 14, lines 10-15).

14. For claim 5, Knauft teaches a web site established in a communication network comprising:

- a. A data manager (Fig. 2, #216), for storing subscription information to be provided across said communication network (col. 1, line 55 – col. 2, line 2);
- b. A transmission source determiner (Fig. 3, #218), for determining whether a user who is the transmission source of an access request has paid a fee for said subscription information (Fig. 6, #540); and
- c. A response unit (Fig. 3, #204), for transmitting, in accordance with the determination made by said transmission source determiner, said subscription information to a user who has paid said fee for said subscription information (col. 14, lines 15-37), and instead of said subscription information (Fig. 7, #700), transmitting at no cost a description of said subscription information to a user who has not paid said fee (Fig. 9; col. 14, lines 37-65).

15. Claims 6 and 7 are drawn to the limitations in claims 1 and 4. Therefore, since claims 1 and 4 are rejected, claims 6 and 7 are also rejected for the reasons above.

16. Claims 8 and 9 are drawn to the limitations in claims 1-3. Therefore, since claims 1-3 are rejected, claims 8 and 9 are also rejected for the reasons above.

17. Claims 10 and 11 are drawn to a method that effectively describes the activities undertaken by the hardware system as drawn in claims 1 and 2. It is well known in the art that the underlying method of a given system is functionally equivalent to said system. Therefore,

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since claims 1 and 2 are rejected, then claims 10 and 11 are also rejected for the reasons above.

A teaching regarding the method/system equivalence is available upon request.

18. Claims 12-15 are drawn to a software system that effectively describes the limitations of the hardware system drawn in claims 1 and 2. It is well known in the art that hardware and software embodiments of the same method and functional limitations are equivalent. Therefore, since claims 1 and 2 are rejected, claims 12-15 are also rejected for the reasons above. A teaching regarding the hardware/software equivalence is available upon request.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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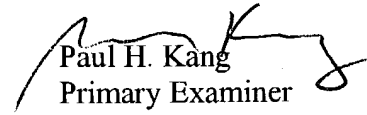
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Melvin H Pollack

Examiner

Art Unit 2141


Paul H. Kang
Primary Examiner

MHP

02 September 2004